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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,499	02/19/2002	David Higgs	5478-8A.1	2448

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EXAMINER

SAYALA, CHHAYA D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/076,499	Applicant(s) HIGGS ET AL.	
	Examiner C. SAYALA	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 8-14, 54, 55, 57, 58, 60, 61 and 63 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 42-53, 56, 59 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 8-14, 54-55, 57-58, 60-61, 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 3 and 7, 42-53, 56, 59, 62 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These claims are drawn to a protein concentrate that had been restricted out in a previous Office action and since applicant had already elected the claims to a protein meal, the claims drawn to a protein concentrate were withdrawn as being non-elected claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 3, 7, 42-53, 56, 59, 62 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

The disclosure is objected to because of the following informalities:

In the amendment to the specification at page 1, lines 3-7, the filing date of the "U.S. application" serial number 09/566728 should be inserted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The amendment filed 11/05/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant has stated that the specification was revised to conform with the claims "as currently amended and also to improve the form and clarity of the specification". In doing so, he has introduced "new matter" into the specification, quite extensively.

The following changes to the specification were not found in the specification, as originally filed:

Replacement of the "second" aspect as a "first" aspect and cancellation of the "first" aspect, as originally filed.

The same may be said of the "second" and "third" aspects.

Deletion of whole paragraphs on pages 6-8 constitute new matter. Furthermore, it is not clear how the cancellation "improves the form and clarity of the specification".

The amendment introduced at page 9, lines 1-13 describing "temperature and time sufficient" and the phrase stating "improves digestability and reduce moisture content"

Applicant's overhaul of the steps at page 9, (see amendment, page 4 of 25) could not be found in the specification as originally filed.

Applicant's amendment at page 5 of 25, stating "any of" at paragraph 3, "any of the above at paragraph 4 and "Preferably" at paragraph 4 is new matter.

Applicant's deletion of lines 21-29 and lines 1-4 on pages 9 and 10 is also, without clear reasons, new matter.

Applicant's insertion of the new amendment at page 14 and deletion of entire pages at pages 15-19, 22 and deletion of lines at pages 20-21, 23-24 is also objected to as being new matter by deletion.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8-14, 54-55, 57-58, 60-61, 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1074605 or Sakai et al. (US Patents 4946598 and 6517885) in view of EP 0925723, Kozlowska et al. (US Patent 4148789) and Bedford (US Patent 2851357).

EP '605 teaches rapeseed or other oilseeds, subjecting it to heat treatment, dehulling and cold-pressing. Sakai et al. ('598) teach heating the mustard seed (col. 1, lines 55+), cracking and compressing to obtain the oil and simultaneously, it would have been obvious that protein meals are obtained. Although the patent does not teach dehulling, the '885 patent to the same inventor and to the same inventive concept teaches

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dehulling before de-oiling by pressing. It would have been obvious to incorporate such a step in the '598 patent. None of the above patents teaches adding animal offal, does not teach cooking the mixture, or solvent extraction (claim 7), or an antioxidant.

EP '723 teaches a protein-containing feedstuff, wherein, the material that contains the vegetable protein is subjected heat-treatment. The vegetable protein material is also subjected to dehulling (see page 4). At claim 30, the addition of an antioxidant is disclosed. Claim 31 teaches a mixture of vegetable lipids as well as "other animal products". Page 6 teaches cooking the protein and separating the solids from the liquids with a centrifuge/press. The protein is dried to a moisture content of 12% or less, preferably 5-10% (see lines 1-15). '789 teaches extraction of oil from rape seeds. Note in col. 1, the patentees teach at lines 60-65, solvent extraction. Also see col. 2, line 19.

Cols. 3 and 4 in the Bedford patent teaches in Egs 5-8, the addition of soybean to fish offals and cooking the mixture, and separating the stickwater and oil. Note the ratios of soybean oil to fish.

Thus it appears that each and every limitation was known in prior art for is intended use, and it would have been obvious to incorporate such steps into the inventions shown by the primary references '605, '598 and '885' all patents being drawn to the same feedstuff. The consideration of the applied patents considered as a whole renders obvious the instant claims.

Response to Arguments

Applicant's arguments filed 11/05/2004 have been fully considered but they are not persuasive.

Applicant has criticized the EP reference for not showing the animal offal, the US '598 patent for showing the mustard seed, which incidentally, is also an oilseed, and for not teaching it in combination with animal offal. The EP'605 patent is criticized for not teaching the steps of "co-processing of a treated oilseed with animal offal" and for not teaching the other steps. Applicant states that the Bedford patent does not teach the co-processing of animal offal and soybean. Fact that specific step is essentially different from that of prior method does not mean that patentably new combination of steps is presented. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Bedford patent teaches the combination as shown by the instant claims. To process them together, when each process was shown separately in prior art, and combining the soybean oil with the offal, which is also taught by the Bedford patent, would require no more than routine skill. Applicant has combined the two sources before cooking, and the reference suggests the combination of soybean oil and fish stickwater obtained by cooking homogenized fish offal. See col. 4, lines 25-57. One of ordinary skill in the art is held accountable not only for the specific teachings of references, but also for the inferences which those skilled in the art

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may reasonably be expected to draw. In re Hoeschele, 160 USPQ 809, 811, (CCPA 1969).

“[T]he test is whether the references, taken as a whole, would have suggested appellant’s invention to one of ordinary skill in the...chemical arts at the time the invention was made.” In re Merck & Co., Inc. 231 USPQ 379 (CAFC 1986). It is well established that a reasonable expectation of success, not absolute predictability is necessary for conclusion of obviousness, In re Longi, 225 USPQ 545, In re Morston, 1961 C.D. 330, In re Clinton, 188 USPQ 365, In re O’Farrell, 7 USPQ2d 1673, 1681 (Fed Cir 1988). Furthermore applicant has unduly limited his view of all that each reference would have fairly suggested to a person having ordinary skill in this art; see the arguments at page 15 of the response. Under 35 USC 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979).

Conclusion

This application contains claims 3 and 7, 42-53, 56, 59, 62 drawn to an invention nonelected with traverse in Paper filed 8/17/2004. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "C. Sayala". The signature is fluid and cursive, with the first letter "C" being large and stylized.

C. SAYALA
Primary Examiner
Group 1700.